

35 U.S.C. §102 Rejection Not Established

An anticipating reference "must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter". In re PPG Industries, Inc. v. Guardian Industries Corp., 75 F3d 1558, 1566, 37 USPQ 2d, USPQ 2d 1618, 1624 (Fed. Cir. 1996). A single reference "must describe and enable the claimed invention, including all claimed limitations, with sufficient clarity and detail to establish that the subject matter existed in the prior art and its existence was recognized by persons of ordinary skill in the field of the invention". In re Crown Operations International, Limited v. Solutia Inc., 289 F3d, 1367, 1375, 62 USPQ 2d, 1917, 1921 (Fed. Cir. 2002).

Claims 1 and 3 have been rejected under 35 U.S.C. §102(b) as being anticipated by Ho (U.S. Patent No. 5,552,971). It has been asserted in the Office Action that Ho '971 patent discloses all the elements and limitations of the claimed subject matter in claims 1 and 3. However, a rejection under 35 U.S.C. §102 is improper since Ho does not disclose an inner globe carrying an image on its surface, wherein the image is being projected onto an inner surface of an outer cover and being visible from the outside the outer cover.

The Ho reference has a shade 1 with a plurality of holes 126. These holes have different shapes. Light passes through these holes and may be filtered by colored protuberance 21. The light then passes through a lens and enters an observer's eye. There is clearly not an image disposed on an outer surface of an inner globe. Figures 4,5,6, and 7 of Ho which "show the working principle of the present invention" clearly show that there is no inner globe carrying an image on its surface. Instead light is transmitted through an aperture and is reflected off internal surfaces until finally passing through a lens. As clearly shown in Figure 7, Ho simply has no image projected onto an inner surface of an outer cover which is visible from the outside the outer cover. The only image formed is the image on the observer's retina. Since at least the claimed features of an inner globe carrying an image on its surface, wherein the image is being projected onto an inner surface of an outer cover and being visible from the outside the outer cover

are not disclosed either expressly or inherently in the Ho, a rejection under 35 U.S.C. §102 is improper, and should be withdrawn.

Additionally, modifying Ho with the features of an inner globe carrying an image on its surface, wherein the image is being projected onto an inner surface of an outer cover and being visible from the outside the outer cover would require a substantial reconstruction and redesign of the elements shown in Ho, as well as a change in the basic principle, as shown in Figures 4-7 , under which the Ho construction was designed to operate. This reconstruction and redesign has long been established to preclude a rejection under 35 U.S.C 103. In re Ratti, 270 F2d 810, 123 USPQ 349 (CCPA 1959). As such there is at the minimum no motivation or suggestion to modify Ho. Therefore, the claimed invention is non-obvious for at least these reasons.

35 U.S.C. §103 Rejection; A Prima Facie Case Not Established

Claims 2 and 4 have been rejected under 35 U.S.C. §103. Claim 2 has been rejected as being unpatentable over Ho (U.S. Patent No. 5,552,971) in view of Wang (U.S. Patent No. 6,039,453). Claim 4 has been rejected as being unpatentable over Ho in view of Wu (U.S. Patent No. 6,022,118).

The courts have established the legal concept of *prima facie* obviousness and the initial burden of factually supporting any *prima facie* conclusion of obviousness rests on the Examiner. To properly establish a *prima facie* case of obviousness three basic requirements must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations. MPEP § 2143.

Rejection of Claim 2 Improper

A rejection of Claim 2 under 35 U.S.C. §103 has not been properly established since there is no motivation or suggestion to combine the references of Ho and Wang. The Ho reference clearly is directed toward transmitting light through an optical system with reflective surfaces and a lens assembly to create an image on an observer's retina. At least Figure 7 of Ho shows this principle in detail. The disclosed principle of Ho makes it clear that one having ordinary skill in the art at the time the claimed invention was made would not find motivation or suggestion to do what the Applicant has done in at least having an inner globe carrying an image on its surface, wherein the image is being projected onto an inner surface of an outer cover and being visible from the outside the outer cover. For at least this reason a rejection under 35 U.S.C. 103 is improper.

A rejection under 35 U.S.C. §103 of claims 2 is additionally improper for at least the reason that the prior art references when combined do not teach or suggest all of the claimed limitations. It is clear that neither the Ho nor Wang references teach or suggest at least an inner globe carrying an image on its surface, wherein the image is being projected onto an inner surface of an outer cover and being visible from the outside the outer cover.

Furthermore, configuring the Ho reference to create an image anywhere but an observer's retina is clearly not taught or suggested. In fact such a proposed modification or combination would require a substantial reconstruction and redesign of the elements shown in Ho, as well as a change in the basic principle under which the Ho construction was designed to operate as evidenced by the Ho figures 4-7. This reconstruction and redesign has long been established to preclude a rejection under 35 U.S.C 103. In re Ratti, 270 F2d 810, 123 USPQ 349 (CCPA 1959). For at least these reasons, a proper rejection under 35 U.S.C. §103 has not been established.

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Rejection of Claim 4 Improper

A rejection of Claim 4 under 35 U.S.C. §103 has not been properly established since there is no motivation or suggestion to combine the references of Ho and Wu. The Ho reference clearly is directed toward transmitting light through an optical system with reflective surfaces and a lens assembly to create an image on an observer's retina. At least Figure 7 of Ho shows this principle in detail. The disclosed principle of Ho makes it clear that one having ordinary skill in the art at the time the claimed invention was made would not find motivation or suggestion to do what the Applicant has done in at least having an inner globe carrying an image on its surface, wherein the image is being projected onto an inner surface of an outer cover and being visible from the outside the outer cover. For at least this reason a rejection under 35 U.S.C. 103 is improper.

A rejection under 35 U.S.C. §103 of claim 4 is additionally improper for at least the reason that the prior art references when combined do not teach or suggest all of the claimed limitations. It is clear that neither the Ho nor Wu references teach or suggest at least an inner globe carrying an image on its surface, wherein the image is being projected onto an inner surface of an outer cover and being visible from the outside the outer cover.

Furthermore, configuring the Ho reference to create an image anywhere but an observer's retina is clearly not taught or suggested. In fact such a proposed modification or combination would require a substantial reconstruction and redesign of the elements shown in Ho, as well as a change in the basic principle under which the Ho construction was designed to operate as evidenced by the Ho figures 4-7. This reconstruction and redesign has long been established to preclude a rejection under 35 U.S.C 103. In re Ratti, 270 F2d 810, 123 USPQ 349 (CCPA 1959). For at least these reasons, a proper rejection of claim 4 under 35 U.S.C. §103 has not been established.

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In summary, Applicant has addressed each of the rejections within the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is earnestly solicited.

Respectfully Submitted,
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